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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HARALD VATER, HERMANN DREXLER, and
ERIC JOHNSON

Appeal 2012-000793
Application 09/700,656
Technology Center 2400

Before JEFFREY S. SMITH, BRUCE R. WINSOR, and JENNIFER S. BISK, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

This is a decision on rehearing. We have jurisdiction under 35 U.S.C. § 6(b). Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52 (2007).

ISSUES ON REHEARING

Appellants contend that the Board misapprehended or misunderstood Appellants' argument concerning why the prior art could not have been obviously modified to obtain the claimed method. Request 1. Appellants assert that contrary to the findings of the Examiner and the Board, it would be "impossible to modify the method of Kocher to obtain the claimed invention." *Id.* Appellants also assert for the first time, in a footnote, that Kocher is not prior art to the present application because the teachings relied upon by the Examiner and the Board are not found in the earliest priority application for the Kocher publication. *Id.* at n.1.

ANALYSIS

We have reconsidered our decision of August 16, 2012 ("Decision"), in light of Appellants' arguments in the Request for Rehearing, and Appellants have not convinced us of error therein.

Appellants' arguments are similar to their arguments presented in their Appeal Brief and Reply Brief. Appellants assert that their argument is not an argument against physical combination of the references, as implied by the Board's explanation. Request 1. Instead, Appellants contend that their argument is "a detailed review of the actual teachings of Kocher, which are relevant to a determination of the 'collective teachings' of the references relied on by the Board." *Id.* Specifically, Appellants assert that the Board overlooked page 12 of the Appeal Brief.

The main thrust of the argument on page 12 of the Appeal Brief and the bulk of the Request for Rehearing is that "the step of falsifying data in Kocher . . . is only performed AFTER the step of performing the

additional permutation perm” and thus “an **essential** feature of the method of Kocher . . . cannot be omitted without rendering the method of Kocher inoperative.” App. Br. 12 (emphases in original); *see also*, Request 2-6.

As explained in our Decision, we are not persuaded by Appellants’ arguments. We find rational the Examiner’s reasoning that “the teachings of Cordery in combination with the method of Kocher would indeed have led one of ordinary skill to use pre-calculated auxiliary values rather than calculating them on the fly, in order to protect the algorithm and secret key used.” Ans. 7 (citing Cordery, col. 3, ll. 11-13). Thus, the Examiner has presented a *prima facie* case of unpatentability. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *quoted with approval in KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (finding that to support a *prima facie* case of obviousness, a rejection must include “some articulated reasoning with some rational underpinning”).

Therefore, the burden shifts to Appellant to prove patentability. *In re Sullivan*, 498 F.3d 1345, 1351 (Fed. Cir. 2007) (“[W]hen a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability.”). Appellants again neglect to address the relevant inquiry—whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the combined teachings of the references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Instead, as in the Appeal and Reply Briefs, Appellants embark in a detailed discussion of what the prior art discloses and conclude that the collective teachings do not make obvious the claimed method. This is done without any discussion of the knowledge of a person of skill in the art and without any convincing rebuttal to the findings of the Examiner to the contrary.

At various points, Appellants' appear to imply that Kocher teaches away from the claimed method. *See, e.g.*, Request 6 ("the highlighted passage [in Kocher] teaches that pre-storing of auxiliary data is unnecessary, and suggests that this would be undesirable") (emphasis in original). But Appellants' do not point to any language in Kocher that clearly criticizes or discredits the pre-storing of data. *See generally* Request. Instead, Appellant argues that Kocher "suggests" that pre-storing would be undesirable "because it would add security requirements that are rendered unnecessary by the use of *perm* (the 'bit order table')." Request 6. Appellants provide no persuasive evidence to support this assertion or explain why the Examiner's finding that a person of ordinary skill would find this obvious is incorrect. In the absence of such support, we are not persuaded that a person of ordinary skill would be discouraged from pre-storing data. *See Syntex LLC v. Apotex, Inc.*, 407 F.3d 1371, 1380 (Fed Cir. 2005) ("What a reference teaches or suggests must be examined in the context of the knowledge, skill, and reasoning ability of a skilled artisan. What a reference teaches a person of ordinary skill is not . . . limited to what a reference specifically 'talks about' . . . [A] reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant's invention."). Appellants' arguments, which make no reference to the knowledge of a person of ordinary skill in the art, are not persuasive. *See generally*, Request.

Appellants' also appear to argue that the proposed combination of Kocher and Cordery would render the "method of Kocher inoperative." App. Br. 12. Again, Appellants provide no persuasive evidence or explanation to support this conclusion. We are thus not convinced that the Examiner's findings to the contrary are erroneous. *See In re Ratti*, 270 F.2d 810, 813

(CCPA 1959) (finding that a combination was not a proper ground of rejection only when the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principles under which the [primary reference] construction was designed to operate”).

To the extent that Appellants’ argue that Kocher is not properly prior art because the teachings relied upon by the Examiner and Board are not found in the earliest priority application for Kocher, *see* Request 1, n. 1, that argument is newly presented in the Request for Rehearing. *See generally* App. Br.; Reply Br. Appellants do not assert that the argument falls into one of the exceptions that allow for a new argument, and the argument does not address any point in our decision misapprehended or overlooked. Therefore we do not address it. *See* 37 C.F.R. §§ 41.37(c)(iv), 41.52(a)(1) (argument not included in the brief or reply brief will be refused consideration unless it falls within one of the enumerated exceptions of §§ 41.52(a)(2)-(4)).

In conclusion, based on the foregoing, Appellants’ Request for Rehearing is granted to the extent that we have reconsidered our Decision, but is denied with respect to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED